

REMARKS

This paper is filed in response to the Office Action mailed June 14, 2007 (hereinafter "Office Action"). Claims 1, 12, 15, 24, 27, and 37 are currently pending in the application and stand rejected. Specifically, Claims 1, 12, 15, 24, 27, and 37 were objected to for informalities. Claims 1, 12, 15, 24, 27, and 37 were rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicants regard as the invention. Claims 1 and 27 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 7,130,841, issued to Goel et al. (hereinafter "Goel et al."), in view of U.S. Patent No. 6,594,670, issued to Genser (hereinafter "Genser"), and U.S. Patent Application Publication No. 2006/0080306, to Land et al. (hereinafter "Land et al."). Claims 12 and 37 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Goel et al., Genser, and Land et al., in view of U.S. Patent Application Publication No. 2002/0059163, to Smith (hereinafter "Smith"). Claim 15 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Goel et al., in view of U.S. Patent No. 6,324,566, issued to Himmel et al. (hereinafter "Himmel et al."), Genser, and Land et al. Claim 24 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Goel et al., Himmel et al., Genser, and Land et al., in view of Smith.

Claim Objections

Claims 1, 12, 15, 24, 27, and 37 were objected to for informalities. Applicants have amended the aforementioned claims to overcome the objections for informalities.

Claim Rejections Under 35 U.S.C. § 112, Second Paragraph

As noted above, Claims 1, 12, 15, 24, 27, and 37 were rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicants regard as the invention. Applicants have amended Claims 1, 12, 15, 27, and 37 to further clarify claim language and more distinctly claim the subject matter, but

not for purposes of patentability over the prior art. Applicants respectfully submit that the aforementioned claims, as amended, are allowable under 35 U.S.C. § 112, second paragraph, and request that the rejection of these claims on this ground be withdrawn.

Rejection of Claims 1, 12, 15, 24, 27 and 37 under 35 U.S.C. § 103(a)

To establish a *prima facie* case for obviousness under 35 U.S.C. § 103, three basic criteria must be met. First, the prior art reference (or references when combined) must teach or suggest all the claim limitations. Second, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine the reference teachings. Finally, there must be a reasonable expectation of success. (M.P.E.P. § 2142.)

Independent Claims 1 and 27

Claims 1 and 27 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Goel et al., in view of Genser and Land et al. Specifically, it is asserted in the Office Action that the Goel et al. reference teaches all of the elements of Claim 1, except for the elements of: (i) determining that the at least one other computing device is not available to receive a content query; (ii) recalling the record of the result of the merging the identification of data stored on the host computing device . . . and the identification of data stored on at least one computing device . . . (iii) merging the identification of data stored on the host computing device . . . and the record of the result of the merging . . . and (iv) generating a result of the merging Next, it is stated in Office Action that although Goel et al. do not disclose these elements, Genser teaches "maintaining results of a previous search, recalling the results of the previous search, merging the results of the previous search with a current search, and displaying the results of the merging." (See Office Action, pp. 5-6.) As for the element of determining that the at least one other computing device is not available to receive a content query, it is asserted in the Office

Action that Land teaches this element. Applicants respectfully disagree for the reasons set forth below.

Genser fails to supply the teachings missing from Goel et al. Genser discloses a user action of entering a search term and the subsequent action wherein the user may type another term into the search term entry field and click the "find" button. (Genser, Col. 9, lines 45-63.) Genser further discloses a user action of adding a search refine term wherein the user may type another term into the search term entry field. (Genser, Col. 10, lines 7-8.) Adding a search term to a search query modifies the search criteria, resulting in two different search queries based on two different sets of criteria. Genser does not disclose merging the identification of data stored on the host computing device associated with the second user request, wherein the *second user request* corresponds to *the set of criteria* also corresponding to an initial user request, and the record of the result of the merging the identification of data stored on the host computing device and the identification of data stored on the at least one computing device, as recited in amended Claim 1.

Moreover, Land et al. fail to supply the teachings missing from Goel et al. and Genser. It is asserted in the Office Action that Claims 1 and 22 of Land et al. teach "determining that a remote server is unavailable to receive a query, and *performing a local search*." (Emphasis added.) In contrast, Claim 1, when read in context, recites "determining that at least one other computing device is not available to receive a content query" and "recalling the record of *the result of merging*." (Emphasis added.) Therefore, a *prima facie* case for obviousness under 35 U.S.C. § 103 has not been made in the Office Action as Goel et al., Genser, and Land et al., alone or in combination, do not teach or suggest all of the limitations of Claim 1. Amended Claim 1 is thus submitted to be allowable for at least these reasons.

Independent Claim 27 includes similar recitations as Claim 1 and thus, is submitted to be allowable for at least the same reasons discussed above with respect to Claim 1.

Dependent Claims 12 and 37

Claims 12 and 37 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Goel et al., Genser, and Land et al., in view of Smith. Claims 13 and 37 depend from independent Claims 1 and 27, respectively. Therefore, these claims are submitted to be allowable for at least the same reasons discussed above with respect to their respective independent claims.

Independent Claim 15

Claim 15 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Goel et al., in view of Himmel et al., Genser, and Land et al. Applicants respectfully disagree for the reasons set forth below.

It is asserted in the Office Action that Himmel et al. teach the recitation "querying to identify content associated with a unique user identifier" as recited in Claim 1, which recitation the Office Action acknowledges is not taught by Goel et al., Genser or Land et al. However, Claims 5 and 11 of Himmel et al. (which claims were cited in the Office Action in support of this rejection) merely disclose "determining *client* specific data associated with the requesting *client*" after "receiving a *client* query from a requesting *client*." In contrast, Claim 15 recites "automatically querying the two or more computing devices . . . to identify the contents of local computing device storage locations associated with a unique *user identifier*." Accordingly, the Himmel et al. reference does not remedy the deficiencies of Goel et al., Genser and Land et al. and a *prima facie* case for obviousness under 35 U.S.C. § 103 has not been made in the Office Action. Claim 15 is thus submitted to be allowable for at least these reasons.

Applicants also note that Claim 15 includes many of the same recitations as Claims 1 and 27, which recitations, as discussed above are not taught, disclosed or suggested by Goel et al., Genser, and Land et al. Moreover, Himmel et al. does not remedy these deficiencies as it

is directed entirely different subject matter, i.e., a method for providing a set of bookmarks in a browser. Accordingly, Claim 15 is submitted to be allowable for at least this additional reason.

Dependent Claim 24

Claim 24 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Goel et al., Himmel et al., Genser, and Land et al., in view of Smith. Claim 24 depends from independent Claim 15. Therefore, Claim 24 is submitted to be allowable for at least the same reasons discussed above with respect to Claim 15.

CONCLUSION

In view of the foregoing amendments and remarks, applicants submit that the above-referenced patent application is in condition for allowance. Reconsideration and reexamination of the application and allowance of the pending claims is solicited. If the Examiner has any questions, the Examiner is invited to contact the undersigned at the number provided below.

Respectfully submitted,

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